

U.S. Serial No. 09/205,318
Appellant's Reply Brief Pursuant to 37 C.F.R. § 41.50

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : LEPAGE et al.
U.S. Serial No. : 09/205,318
Filed : December 4, 1998
Title : Roll-Up Door for Vehicle Shelters
Art Unit : 3634
Examiner : Blair M. Johnson

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APPELLANT'S REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.50

Dear Sir:

In response to the Supplemental Examiner's Answer mailed June 8, 2005, please enter the following Reply Brief and consider the following remarks. This response is timely filed within six-months of the mailing date of the Supplemental Examiner's Answer and is accompanied by a Petition to Suspend The Rules Under 37 C.F.R. §1.183, requesting this Brief be entered in the interest of justice, as well as a Petition for an Extension of Time under 37 C.F.R. §1.136(b).

Also attached herewith is a copy of a properly executed Power of Attorney under 37 C.F.R. §3.73(b), originally forwarded to the Office on May 25, 2005, appointing the undersigned as an Attorney of Record.

REMARKS

On April 14, 2004, the Board of Patent Appeals and Interferences remanded the present application to the examiner for a determination of whether the rejection of the claims under 35 U.S.C. § 251 remains appropriate in view of Ex parte Eggert. In the Supplemental Examiner's Answer mailed June 8, 2005, the examiner maintained the current rejections and, instead of briefing the Board on the merits of the rejections based upon the Board decision in Ex parte Eggert, the examiner noted that the Board's ruling in Eggert is "not applicable" (emphasis original) and essentially imposes a per se rule of reissue recapture as specifically rejected by the Board decision in Eggert.

The Examiner Impermissibly Imposes a per se Rule of Reissue Recapture

As stated by the Board, the language of 35 U.S.C. § 251 permits broadening claims in a reissue patent. *Ex parte Eggert*, 2003 Pat. App. LEXIS 27, 5;67 U.S.P.Q.2D 1716, (BPAI, 2003). That is not to say, however, that an applicant is unfettered in amending their issued claims in a reissue patent. *Id.* at 6. However, to adopt a per se rule of reissue recapture to prevent an applicant from retreating from any claim limitation determined to have secured allowance of the original patent would be "contrary to the language of 35 U.S.C. § 251," and has been specifically rejected by the Board. See *Id.* at 5-6 (stating that the Board "[refuses] to apply a per se rule that, after a limitation is added to a claim or argued to be significant in distinguishing a claim over prior art applied in a rejection, any reissue claim which does not contain that limitation is per se impermissible.")

In the Examiner's Supplemental Answer, however, the examiner contends that

The claims on appeal (claims 20-27 in the reissue application) omit in their entirety surrender-generating limitation, i.e., the limitation(s) added in the original prosecution to define over the art to secure allowance of the patent. This is because the limitations of patent claim 1 which are represented as elements X and Y above, in their entirety, are essentially absent from the reissue claims 20-27. Therefore, the claims impermissibly recapture what was previously surrendered.

U.S. Serial No. 09/205,318
Appellant's Reply Brief Pursuant to 37 C.F.R. § 41.50

(Supplemental Examiner's Answer, Page 8) (emphasis removed). The examiner is essentially applying the improper *per se* rule that the Applicants are barred from obtaining any claim that does not include each and every limitation added to a claim or argued by the Applicants during prosecution of the original patent application. In particular, the examiner contends that because elements X and Y are not in reissue claims 20-27 "in their entirety," "the claims impermissibly recapture what was previously surrendered." This approach has been expressly rejected by the courts and by the Board. *See Eggert* at 26, ("This approach, while certainly relatively simple in its application, has been expressly rejected by the Court of Customs and Patent Appeals (CCPA) and the Court of Appeals for the Federal Circuit (Federal Circuit).")

Rather, as properly noted by the Board, a proper analysis "focuses on that which the prosecution history indicates was given up or conceded to be unpatentable by the applicant, i.e., the 'surrendered subject matter,' in order to obtain a patent, for this is the subject matter which cannot be recaptured in reissue." *Eggert* at 25. Specifically, the Board states that "the first step in applying the recapture rule is to determine whether and in what 'aspect' the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect." *See Eggert* at 33, (citing *In re Clement*, 131 F. 3d 1464 (Fed. Cir. 1997)). "The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter." *Id.*, (citing *Id.* at 1468-69). Finally, the Board notes that "to determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and amendments made to the claims in an effort to overcome a prior art rejection." *Id.* at 34.

In adopting the three-part Clement test, the Board specifically analyzed the Pannu case relied upon by the examiner and noted that it "also fails to provide support for the *per se*

rule [and] expressly endorses the three-step process for applying the recapture rule set forth in Clement.” *Eggert* at 42. The Board “acknowledged” that while Pannu may be read to “provide limited support for the per se rule,” the Board “decline[d] to extract [from Pannu] a generalized rule that a reissue claim which omits a limitation relied upon during prosecution of the patent application is per se impermissible under the recapture rule.” *Eggert* at 44. Thus, even under Pannu, the “proper inquiry requires a fact-specific analysis in each case to determine whether the patentee is attempting to recapture by reissue subject matter that was surrendered during the prosecution of the patent application. *Id.*

Accordingly, contrary to the assertion by the examiner, the Board’s decision in Eggert is applicable to the present matter. More particularly, the Applicants submit that the Board’s endorsement of the three step process for applying the recapture rule is controlling in the present case, and therefore that claims at issue should be analyzed in accordance with that decision.

Analysis under Ex parte Eggert

As previously briefed in detail, and as highlighted below, the prosecution history of the original patent makes it clear that the Applicants did not surrender subject matter in an aspect germane to a prior art rejection, because the Applicants neither amended the claims nor presented arguments that constituted an admission that these limitations were necessary to overcome the prior art. Therefore, in analyzing the current reissue claims in view of Eggert, it is clear that the recapture rule does not bar the claim.

As detailed, “the first step in applying the recapture rule is to determine whether and in what ‘aspect’ the reissue claims are broader than the patent claims.” *Eggert* at 33. The Examiner alleges that the current reissue claims are broader than the original claims because

U.S. Serial No. 09/205,318
Appellant's Reply Brief Pursuant to 37 C.F.R. § 41.50

“limitation X is completely omitted from the reissue claims 20-27”¹ and reissue claim 20 is “a restated form of original claim 1 as it appeared prior to the insertion of limitation Y.”² The examiner further states that the “applicant made the choice of inserting those claim limitations into the original independent claim” and therefore “on reissue, applicant is not permitted to completely delete these added limitation,” (Supplemental Examiner’s Answer, page 7). The examiner, however, is relying once again upon the narrow per se rule of reissue recapture rejected in Eggert.

Specifically, the examiner fails to apply the Board decision that once the claim elements are identified, “the second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter.” *Eggert* at 35. To determine the scope of surrendered subject matter one must “look to the prosecution history for arguments and amendments made to the claims in an effort to overcome a prior art rejection.” *Id.* In contrast, the examiner states that “every time the claims are narrowed by amendment, subject matter is surrendered.” (Supplemental Examiner’s Answer, page 10, citing *In re Clement*). This is simply not the holding of the Board. In particular, the Applicants note that the amendments made to the original claims were not made in an effort to overcome any reference, and regardless, the examiner’s reasoning is flawed, because not all amendments are surrender of subject matter. As clarified in Eggert, the Board states that “deliberate cancellation or amendment of a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable, but is not dispositive where other evidence in the prosecution history indicates to the contrary.” *Id* at 34 (emphasis added). Accordingly, it follows that even if the

¹ Limitation X is defined by the examiner as a “flexible closure means having a shape which tapers in a direction of said roller means”

² Limitation Y is defined by the examiner as “wherein in said closed position, said section of said flexible closure means substantially completely closes the door opening.”

amendments were presented to overcome a reference (which they were not), it is not dispositive that the Applicants admitted to claim scope surrender, as stated by the examiner, but is merely a suggestion as held by the Board.

The Applicants made minor amendments as to the form of the claims during prosecution of the original claims. However, none of these amendments amounted to surrender of the now-sought subject matter. (Brief on Appeal, page 11). First, the original examiner took issue with the Applicants' choice to claim a closure means "said to have a shape complementary to the door opening." Per the examiner, that language was vague and indefinite and, in response, the Applicants amended the claims to overcome the non-art based rejection under 35 U.S.C. § 112, and not in an effort to overcome the cited reference. Specifically, the Applicants amended the claim per the examiner's request to clarify that "substantially complementary to that of the door opening" is equivalent to a shape "which tapers in direction of said roller means."

Additionally, the other amendments to the claims (including Element Y in the examiner's parlance) were made among "minor clerical amendments," each of which made "to ensure proper antecedent basis" throughout the claim. Again, the amendments were not presented in an effort to overcome a reference. For example, the amendment adding that "in said closed position, said section of said flexible closure means substantially closes the door," merely expressly recites that which is implicit in the term "closed position." In this matter, the prosecution history makes it clear that contrary to the assertions by the examiner, the deliberate amendment of the claims were not admissions that the scope of the claims before amendment were unpatentable, and in fact were merely clarifying the claims with language of equivalent scope.

Because the amendments made were not presented in an effort to overcome a prior art rejection, in following Eggert, one must then look to the prosecution history for arguments

made to overcome the prior art. *Eggert* at 33 (citing *Hester Indus., Inc., v. Stein Inc.*, 142 F. 3d 1472 (Fed. Cir. 1998)). In discussing claim arguments, the Board noted that while “surrender can occur through argument alone,” the “recapture rule may be avoided in some circumstances where the reissue claims were materially narrowed in respect other than those in which the reissue claims were broadened. *See Id* at 41. Particularly, in *Hester*, the court found that “[i]n the context of a surrender by way of argument, this principle, in appropriate cases, may operate to overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspect”) (emphasis added). Additionally, the Board held that “Hester leaves open the possibility that such reissue claims may avoid the recapture rule where they are materially narrowed in other respects.”³ *Id* at 42.

The present reissue claims are narrowed in respects other than those in which the reissue claims were broadened and, more particularly, it is clear that the Applicants are attempting to reissue a scope of protection related to an overlooked aspect. For example, while the examiner admits that while the reissue claims 20-27 are broader than the original patent claims 1-19 by not including limitations X and Y, the examiner also notes that “there is narrowing of the claims (e.g., ‘guide engagement members’, ‘elastic member coupled to the curtain’, ‘laterally inwardly biasing means’) not related” to those limitations (Supplemental Examiner’s Answer, page 9). In other words, the examiner recognizes that the reissue claims, while broadened in some aspects and narrowed in others, are attempting to capture an overlooked aspect, i.e., claims of differing scope. This is bolstered by the fact that

³ In analyzing the arguments presented by the patentee, the court in *Hester* noted that the patentee “argued that each of these limitations was ‘critical’ with regard to patentability,” that the limitations were “very material,” and that “these repeated arguments constitute an admission by [the patentee] that these limitations were necessary to overcome the prior art.” *Hester* at 1482. (emphasis added)

**U.S. Serial No. 09/205,318
Appellant's Reply Brief Pursuant to 37 C.F.R. § 41.50**

the claims as amended are allowable over all of the cited art, even without the limitations the examiner states as made in an effort to overcome the art. To illustrate this, the Board must look to the prosecution history of the present case to determine whether the arguments made by the patentee were not only presented to overcome the prior art rejections, but that the arguments made it clear that the limitations were critical and necessary to overcome the prior art. *Hester* at 1482.

In the present case the Applicants made numerous distinctions over the prior art, including those mentioned in conjunction with the amended language.⁴ However, none of these arguments amounted to surrender of the now-sought subject matter but, rather, were merely indications of numerous elements that were different. (Brief on Appeal, page 11). More particularly, the Applicants do not describe the criticality or materiality of any of the individual claim elements. Accordingly, each of the claim amendments presented were merely one of many distinctions argued by the Applicants and therefore, clearly none were made to overcome any prior art reference. Thus, as shown by the record, none of the claim amendments were “germane” to a prior art rejection, but rather were merely pointed out as one of many distinctions between the subject matters.

Therefore, the prosecution history of the original patent makes it clear that the Applicants did not surrender subject matter in an aspect germane to a prior art rejection, because the Applicants neither amended the claims nor presented arguments that constituted an admission that these limitations were necessary to overcome the prior art. Thus, it is clear that the recapture rule does not bar the current reissue claims.

⁴ For example, the Applicants also noted that the Klose patent was distinguished as disclosing a structure that did not cover the entire windshield, or that the Ojima patent required rollers at the bottom edges of trapezoidal openings, and that each of the patents have panels that allow for gaps on their trapezoidal lateral sides and do not enclose the entire doorway opening.

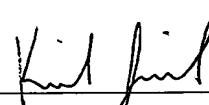
**U.S. Serial No. 09/205,318
Appellant's Reply Brief Pursuant to 37 C.F.R. § 41.50**

Conclusion

In view of the foregoing, it is respectfully submitted that the rejections of reissue claims 20-27 are based on legal and factual errors and that all of the pending claims should be allowed.

Respectfully submitted,

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Dated: December 8, 2005

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STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: Rite-Hite Holding CorporationApplication No./Patent No.: 09/205,318 Filed/Issue Date: 12/4/1998Entitled: Roll-Up Door For Vehicle Shelters

Rite-Hite Holding Corporation, a corporation
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

- the assignee of the entire right, title, and interest; or
- an assignee of less than the entire right, title and interest.
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The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Signature

Keith R. Jarosik

Printed or Typed Name

Date

(312) 580-1133

Telephone Number

Attorney for Applicant

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 a Wisconsin Corporation
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SIGNATURE of Assignee of Record

The individual whose signature and title is supplied below is authorized to act on behalf of the assignee

Signature		Date 20. MAY. 05
Name	MATTHEW C. MCNEILL	Telephone (414) 362-0610
Title	ASST. SECRETARY	

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